

R E M A R K S

Claims 1-4 are pending in the present application.

The Examiner has required election in the present application between Group I, claims 1-3, and Group II claim 4.

For the purpose of examination of the present application, Applicants elect, with traverse, Group I, Claims 1-3.

It is respectfully requested that the Examiner reconsider the Restriction Requirement. Applicants submit that the examples provided in the Office Action for concluding that Groups I-II are distinct inventions are not persuasive. Additionally, Applicants submit that the Examiner is not seriously burdened by examining Groups I-II in a single application.

The MPEP at 802.01 defines ‘distinct’ inventions as two inventions which have separate utility, i.e. the inventions as claimed are not connected in at least one of design, (e.g., structure or method of manufacture), operation, (e.g., function or method of use), or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is patentable over the other.

In the instant case, the Office Action states that Groups I and Group II are distinct from each other because the “DNA has other utility besides encoding the proteins such as hybridization probes”, (Office Action, page 2). However, the use of the inventive polynucleotides as hybridization probes might not, without more, be a sufficient utility. For example, the Revised Interim Utility Guidelines Training Materials (1999), at Example 9, describes a cDNA fragment as being useful as a probe for obtaining its corresponding full-length

gene. Such a use was deemed to lack a specific and substantial utility. Additionally, the MPEP states that a claim directed to a polynucleotide disclosed to be useful as a “gene probe” fails to satisfy the specific utility requirement unless a specific DNA target is also disclosed. MPEP 2107.01. Moreover, the CAFC in *In Re Fisher*, 421 F.3d 1365 (Fed. Cir. 2005) endorsed the PTO Utility Examination Guidelines. Hence, describing inventions as distinct because of a utility that would render an invention unpatentable is not a reasonable example of operation to support the distinction between Group I and Group II.

Additionally, the Office Action states “the proteins can be made by another method such as isolation from natural sources or chemical synthesis.” (Office Action, page 2). Although, theoretically, these methods are possible, practicality dictates that the proteins will be manufactured from the DNA that encodes them. Chemical synthesis of proteins, as well as their extraction from natural sources, are unnecessarily time-consuming and expensive manufacturing methods. Hence, describing inventions as distinct because the polypeptides of Group II can, with great difficulty and expense, be manufactured by methods that are unlikely to be used, are not reasonable examples of design supporting the distinction between Groups I-II.

Finally, a consolidated search of Groups I-II should be undertaken by the Examiner. A consolidated search and examination will make better use of resources than several successive searches and examinations. A proper search for the polynucleotides of Group I and their expression products, *i.e.* the polypeptides of Group II, requires the use of a computer-based search of the *same* set of biosequence databases. There is no rational basis for requiring the Examiner to perform this search more than once. Hence, the search burden will be greater on the Examiner should she restrict the inventions. Therefore, Applicants submit that not only does no serious search burden exist by examining Groups I-II in a single application, there will be less of a search burden for the Examiner.

However, in order to be responsive to the Examiner's Restriction Requirement, Group I, claims 1-3, have been elected with traverse. Applicants reserve the right to file a divisional application directed to the non-elected claims at a later date if it is so desired.

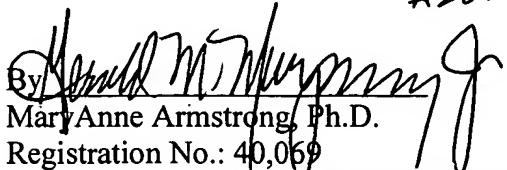

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact MaryAnne Armstrong, Ph.D., Registration No 40,069 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

- ☐ Attached is a Petition for Extension of Time.
- ☐ Attached hereto is the fee transmittal listing the required fees.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: APR 27 2006

Respectfully submitted,

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